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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,864	03/30/2006	Wen-Luan Wendy Hsiao	32144183.4	8549
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WILKINSON & GRIST			EXAMINER	
6TH FLOOR, PRINCE'S BUILDING			GOLDBERG, JEANINE ANNE	
CHATER ROAD, CENTRAL				
HONG KONG,			ART UNIT	PAPER NUMBER
CHINA			1634	
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			08/04/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief		Application No. 10/516,864	Applicant(s) HSIAO ET AL.
		Examiner JEANINE A. GOLDBERG	Art Unit 1634
<p>–The MAILING DATE of this communication appears on the cover sheet with the correspondence address –</p> <p>THE REPLY FILED 27 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.</p> <p>1. <input type="checkbox"/> The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:</p> <p>a) <input type="checkbox"/> The period for reply expires _____ months from the mailing date of the final rejection.</p> <p>b) <input checked="" type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p> <p>Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p> <p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p> <p>NOTICE OF APPEAL</p> <p>2. <input type="checkbox"/> The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).</p> <p>AMENDMENTS</p> <p>3. <input checked="" type="checkbox"/> The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because</p> <p>(a) <input checked="" type="checkbox"/> They raise new issues that would require further consideration and/or search (see NOTE below);</p> <p>(b) <input checked="" type="checkbox"/> They raise the issue of new matter (see NOTE below);</p> <p>(c) <input checked="" type="checkbox"/> They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p> <p>(d) <input type="checkbox"/> They present additional claims without canceling a corresponding number of finally rejected claims.</p> <p>NOTE: <u>See Continuation Sheet.</u> (See 37 CFR 1.116 and 41.33(a)).</p> <p>4. <input type="checkbox"/> The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).</p> <p>5. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): _____.</p> <p>6. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p> <p>7. <input checked="" type="checkbox"/> For purposes of appeal, the proposed amendment(s): a) <input checked="" type="checkbox"/> will not be entered, or b) <input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended. The status of the claim(s) is (or will be) as follows: Claim(s) allowed: <u>none</u>. Claim(s) objected to: <u>none</u>. Claim(s) rejected: <u>1-29</u>. Claim(s) withdrawn from consideration: <u>none</u>.</p> <p>AFFIDAVIT OR OTHER EVIDENCE</p> <p>8. <input type="checkbox"/> The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).</p> <p>9. <input type="checkbox"/> The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fail to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).</p> <p>10. <input type="checkbox"/> The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.</p> <p>REQUEST FOR RECONSIDERATION/OTHER</p> <p>11. <input checked="" type="checkbox"/> The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u></p> <p>12. <input type="checkbox"/> Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____</p> <p>13. <input type="checkbox"/> Other: _____.</p> <p style="text-align: right;">/Jeanine A Goldberg/ Primary Examiner, Art Unit 1634</p>			

Continuation of 3. NOTE: The claims have been amended to broaden the scope to any encoding catenin where applicants initially claimed beta-catenin associated RNA. The broadening to catenin is non-elected and furthermore may not be supported by the instant specification in the generic scope. Newly added Claims 30-37 have been added. The newly added Claims require particular sequence of SEQ ID NO: 4-13 which were not previously claimed or searched. Claim 35 is directed to pair of primers "franking" 2-3 introns. The claim includes a typographical error and may contain new matter. The claims have added a limitation that the volume of blood or serum plasma is from 2-5 ml. This was not previously searched or considered. .

Continuation of 11, does NOT place the application in condition for allowance because: The newly amended claims have not been entered and all of the arguments are directed to the newly amended claims. The response asserts that the 112 first paragraph rejection is erroneous as a matter of law because art references cannot be used unless the inventor is untrustworthy or unbelievable. This argument has been reviewed but is not persuasive. While a later dated publication cannot supplement an insufficient disclosure in a prior dated application to make it enabling, applicant can offer the testimony of an expert based on the publication as evidence of the level of skill in the art at the time the application was filed. Gould v. Quigg, 822 F.2d 1074, 1077, 3 USPQ2d 1302, 1304 (Fed. Cir. 1987). If individuals of skill in the art state that a particular invention is not possible years after the filing date, that would be evidence that the disclosed invention was not possible at the time of filing and should be considered. Here the teachings of Wong illustrate the unpredictability of detecting colorectal carcinoma using beta-catenin.

The response further asserts the 112 rejection is erroneous as a matter of facts. The response asserts the Wong reference supports the present invention. The response asserts that measuring the blood level of b-catenin is a good tool for detecting colorectal cancer. This argument has been reviewed but is not persuasive. The data provided in the chart illustrates the overlapping ranges such that colorectal cancer can not be detected merely by the presence of b-catenin.

Osmer is used to demonstrate that one gene is generally not enough for a diagnostic. Fleischhacker is used to demonstrate differences between serum and plasma levels.

Thus, for the reasons presented above, and those already of record, the pending claims are not enabled.